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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Big Red Machine Motorcycle Company, Inc.

Serial No. 76180997

Fritz Clapp of Law Offices of Fritz Clapp for Big Red
Machine Motorcycle Company, Inc.

Gina M. Fink, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Big Red Machine Motorcycle Company, Inc. (a California
corporation) filed an application on December 15, 2000, to
register on the Principal Register the mark BIG RED MACHINE
for "motorcycles" in International Class 12. The
application is based on applicant's claimed date of first
use and first use in commerce of October 18, 1997.
Applicant disclaimed the word "machine."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark BIG RED for structural parts for three-wheeled utility and recreational all-terrain vehicles in International Class 12,¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Turning first to the involved goods, the Examining Attorney contends that "both parties' goods are types of recreational vehicles and/or structural parts for

¹ Registration No. 1289975, issued August 14, 1984 to Honda Giken Kogyo Kabushiki (Honda) for goods identified as "three-wheeled utility and recreational all-terrain vehicles and structural parts therefor." The Section 8 affidavit (which included a statement regarding excusable non-use), was accepted by the USPTO only for a portion of the original identified goods, specifically, "structural parts." Thus, the cited registration is limited to "structural parts," for such vehicles.

recreational vehicles" (brief, unnumbered page 3); and that motorcycles, all-terrain vehicles and structural parts for both are all sold in motorcycle shops and through on-line retailing web sites. In addition, the Examining Attorney contends that "Honda is at times synonymous with the term 'big red' in terms of racing and motorcycles." (Brief, unnumbered page 4.)

The Examining Attorneys² submitted (i) printouts of numerous third-party registrations to show that consumers are familiar with the fact that the same companies make motorcycles and all-terrain vehicles, as well as structural parts and accessories for both; (ii) printouts of pages from a few web sites to show that both parties' goods emanate from a single source; and (iii) a few excerpted stories retrieved from the Nexis database to show that "Honda" is well known in connection with motorcycles and that "Honda," the company, is well known as "BIG RED."

Applicant takes the position that these goods are completely distinct; that the trade channels and purchasers are completely different; and that the goods are costly and

² Two different Examining Attorneys have been assigned, at different times, to this case.

the purchasers would exercise care in obtaining these goods, thereby avoiding a likelihood of confusion.³ In addition, applicant argues that there is a third-party registration (No. 2121046) for the mark BIG RED for "tow tractors and structural parts therefor"; that registrant (Honda) has ceased using the mark BIG RED for the three-wheeled all-terrain vehicles; and that even when Honda did use the term BIG RED on these goods, it appeared subordinate to the house mark, "HONDA."

The problem with the Examining Attorney's position is that registrant's involved goods, as identified (after the filing and acceptance of registrant's Section 8 affidavit of use), do not include three-wheeled all-terrain vehicles, but rather are limited to structural parts for such vehicles. There is insufficient evidence of record that the same entity offers goods such as applicant's motorcycles, and also offers structural parts for three-wheeled all-terrain vehicles under the same mark. Many of the Examining Attorney's third-party registrations are for motorcycles and all-terrain vehicles and/or for various services offered with respect to both motorcycles and all-terrain vehicles (e.g., providing extended warranty

³ Applicant's attorney averred in a declaration, inter alia, that applicant's motorcycles retail for over \$16,000.

contracts, financing services, retail store services, distributorships). The web sites also generally refer to motorcycles and all terrain vehicles.

Moreover, applicant's motorcycles are expensive and would be purchased only with care. Likewise, presumably, purchasers who seek structural parts for their three-wheeled all-terrain vehicles must purchase such parts with care in order to obtain the proper part.

Simply put, we cannot conclude from the evidentiary record furnished by the Examining Attorney that motorcycles and structural parts for three-wheeled all-terrain vehicles emanate from a single source, such that the careful consumers of these goods would assume a common source.

As a result, even though the respective marks, BIG RED and BIG RED MACHINE, are very similar in sound, appearance, meaning and commercial impression, the record does not support a finding that the contemporaneous use of the mark BIG RED MACHINE by applicant for motorcycles and registrant's BIG RED mark for structural parts for three-wheeled all-terrain vehicles is likely to cause confusion. See *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Thus, on this ex parte record, we are constrained to find that the Examining Attorney has not established a

likelihood of confusion. Of course, the Board makes no finding herein as to what may be shown in any inter partes case involving this application.

Two matters we note for the record. First, the Examining Attorney's evidence regarding the cited mark as being "well known" is not sufficient to establish the likelihood of confusion herein because it is evidence that the registrant itself, Honda, is known as BIG RED. There is no evidence that the registered mark is well known for the involved identified goods, namely, structural parts for three-wheeled all-terrain vehicles.

Second, applicant's argument regarding a single third-party registration for the mark BIG RED is not the reason we have found in applicant's favor. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

Decision: The refusal to register under Section 2(d) is reversed.